

Application Number 10/773,121  
Amendment dated December 7, 2005  
Responsive to Office Action mailed September 7, 2005

### **REMARKS**

This amendment is responsive to the Office Action dated September 7, 2005. Applicants add claims 44-50. Claims 1-50 are pending.

### **Rejection for Obviousness-type Double Patenting:**

The Examiner provisionally rejected claims 1-43 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-43 of copending Application Serial No. 10/718,038 (U.S. Patent Application Publication 2005/0049663) .

Applicants note the provisional status of this rejection. Accordingly, Applicants will address this issue if and when the rejection is formally applied.

### **Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,847,849 to Mamo et al. (hereinafter "Mamo") in view of U.S. Patent Publication 2005/0182470 A1 by Cross, JR. (hereinafter "Cross"). Applicant respectfully traverses the rejection. Cross does not qualify as prior art under 35 U.S.C. §103 with respect to Applicants' claims. 35 U.S.C. § 103(c)(1) reads as follows:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application was filed February 5, 2004 is a continuation-in-part of U.S. utility application no. 10/718,038, filed November 20, 2003, and claims the benefit of U.S. provisional application no. 60/499,207, filed August 29, 2003. Cross was first published on August 18, 2005, after both the actual effective filing dates of the present application. Therefore, with respect to the pending claims, Cross does not qualify as prior art under 35 U.S.C. § 102(b)/103 or § 102(a)/103. Therefore, the provisions of section 103(c)(1) apply to the present application.

Applicant hereby informs the Examiner that the invention claimed in the present application and the subject matter of the Cross reference were, at the time the claimed invention

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was made, owned by the same person or subject to an obligation of assignment to the same person. The recorded assignee of the Cross patent application is Medtronic, Inc. The present application was subject to assignment to Medtronic Inc. at the time of invention and is currently assigned to Medtronic, Inc. The assignment of the present application was recorded on June 21, 2004.

Because the present invention was subject to a common obligation of assignment at the time the invention was made, Cross does not qualify as prior art against the claimed invention per the provisions of 35 U.S.C. § 103(c)(1). Further, as acknowledged by the Examiner, Mamo fails to disclose or suggest at least one requirement of each of Applicant's independent claims 1, 16 and 38. Accordingly the Examiner has failed to establish a prima facie case of non-patentability of any of Applicant's claims 1-43 under either of §§ 102 and 103. Therefore, Applicant respectfully requests withdrawal of the rejections under section 103.

In light of the inapplicability of Cross to the claimed invention, Applicant reserves any comments concerning differences between the claimed invention and the systems described by the Cross and Mamo references.

**New Claims:**

Applicants added claims 44-50 to the pending application. Claims 44 and 45 are dependent on independent claim 1, and are therefore patentable over the presently applied references for the reasons discussed above. Further, like independent claim 1, independent claim 46 requires an elongated dilator defining a dilator lumen sized to advance over a guidewire, the dilator having a substantially conical distal tip, wherein at least a portion of the conical distal tip has a substantially oblong cross-section. Consequently, for at least the reasons stated above, independent claim 46 and dependent claims 47-50 are patentable over the presently applied references. No new matter has been added by the new claims.

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### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. The Applicant does not acquiesce in any of the Examiner's current rejections or characterizations of the prior art, and reserves the right to further address such rejections and/or characterizations.


Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

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